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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,868	09/09/2003	Thomas J. Gretz	1657(Arl)	2095

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EXAMINER

ESTRADA, ANGEL R

ART UNIT PAPER NUMBER

2831

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/657,868	Applicant(s) GRETZ, THOMAS J.	
	Examiner Angel R. Estrada	Art Unit 2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 9 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>09/09/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8 and 10, drawn to a siding box assembly, classified in class 174, subclass 58.
 - II. Claim 9, drawn to a method of mounting a light fixture to a vertical wall of a building, classified in class 174, subclass 48.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the steps of marking a suitable location for a light fixture, creating a hole, providing a light fixture including a base, a mounting bar fasteners, fixture fasteners secured to said mounting bar, cap nuts, securing said mounting bar to said fastener accepting apertures of said post with said mounting bar fasteners are not required. The subcombination has separate utility such as method of mounting an electrical housing to a vertical wall.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Auzville Jackson on January 9, 2004 a provisional election was made with traverse to prosecute the invention of Group I (claims 1-8). Affirmation of this election must be made by applicant in replying to this Office action. Claim 9 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “*integral extension extending from said front surface of said back wall to accommodate a grounding screw*” (claim 4) and “*an electrical fitting inserted within said cable opening*” (claim 6) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: The disclosure does not mention any integral extension extending from said front surface of said back wall of said electrical junction box to accommodate a grounding screw as mentioned in claim 4.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 line 23, "said electrical supply", lacks antecedent basis.

Claim 5 line 1, "said removable wall section", lacks antecedent basis.

Claim 10 line 1, "said mounting block" lacks antecedent basis.

Claim 10 line 2, "said knockouts", lacks antecedent basis.

Claims 2-4 and 6-8 are included because of their dependency.

Allowable Subject Matter

5. Claims 1-8 and 10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

The following is an examiner's statement of reasons for allowance: The primary reason for the indication of the allowability of claims 1-8 and 10 is:

Regarding claims 1-8 and 10 is the inclusion therein in combination as currently claimed of the limitation of a siding box assembly comprising two or more ears extending outwardly from said front peripheral wall, said ears including apertures therein; said front peripheral wall of said electrical junction box having a base and a planar top edge; two or more posts integral with said front peripheral wall of said

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electrical junction box extending from said base to said top edge; said posts including a top planar with said planar top edge of said front peripheral wall of said electrical junction box; said posts including fastener-accepting portions; two or more box-anchoring fasteners; and a cover having an outer periphery a central opening, a front and a rear surface, and a rear peripheral wall extending from said rear surface of said cover and substantially surrounding said central opening; wherein said box-anchoring fasteners secure said electrical junction box to said vertical surface, said rear peripheral wall of said cover slidingly engages said front peripheral wall of said electrical junction box, and said light fixture is secured to electrical junction box thereby creating a completely enclosed electrical junction box for housing all electrical connections between said light fixture and said electrical supply.

This limitation was found in claims 1-8 and 10, and is neither disclosed nor taught by the prior art of record, alone or in combination.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Arnold (US 4,012,580), Cooney (US 6,604,798), Silver (US 4,082,915), Gretz (US 5,804,764; US 6,051,786, US 6,239,368 and US 5, 939, 671) discloses a box assembly.

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7. Any inquiry concerning this communication should be directed to Angel R. Estrada at telephone number (703) 305-0853. The Examiner can normally be reached on Monday-Friday (8:30 -5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (703) 308-3682. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

AE

January 9, 2004

 1/9/04
DEAN A. REICHARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800